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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/609,133

06/26/2003

Mansoor Sarfarazi

UCT-0046-P2

2233

23413 7590 06/21/2007
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EXAMINER

SITTON, JEHANNE SOUAYA

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

06/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/609,133

Applicant(s)

SARFARAZI ET AL.

Examiner

Jehanne S. Sitton

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 May 2007 **FAILS** TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1, 4, 8, 44 and 45.
Claim(s) withdrawn from consideration: 5-7, 11-43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Attachment

1. The proposed amendment filed 5/14/2007 will not be entered because it raises the issue of new matter as well as other issues under 35 USC 112/first paragraph, changes the scope of the claims requiring further search and consideration and presents additional claims without canceling a corresponding number of finally rejected claims. The amendment to recite “the full length optineurin coding sequence encoded by SEQ ID NO: 1” appears to raise the issue of new matter, because the specification does not appear to contemplate a fragment of an isolated nucleic acid molecule which is specifically drawn to the coding sequence of SEQ ID NO: 1, 3, or 5. Although the response cites para 0016 for support, this section of the specification appears to explain the positions of specific Genbank Accession number, rather than defining fragments of the invention. Additionally, in claim 1, the specification does not provide any guidance with regard to position 458 “in the coding sequence of the optineurin gene of SEQ ID NO: 1, 3, or 5” raising issues under 112/2nd para. The amendment to recite “mutant optineurin” in claim 8 raises additional issues under 112/first paragraph written description and enablement. Additionally, although the response cites para 0064 for support for the amendment to recite “consisting essentially of”, this transitional phrase does not find support in the cited para, raising issues under 35 USC 112/2nd para. Additionally, the amendment in claim 45 to recite “approximately” instead of “about” raises new issues that require further search and consideration, as do the addition of newly added claims 46 and 47.
2. Arguments made regarding rejections under 35 USC 102 will not be addressed, as well as arguments made with regard to the amendments to claim 45, and newly added claim 46, as they do not pertain to the instantly pending claims. The arguments with regard to claim 8 and the

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rejection under 35 USC 103 have been thoroughly reviewed but were not found persuasive. The response asserts that there is no motivation to attach the polynucleotide of BE013065 to an array absent some particular function of the target. This argument has been thoroughly reviewed but was not found persuasive. Arrays are constructed with probes to target polynucleotides whose function are not necessarily known, such as gene expression arrays, as well as whole genome arrays. Further, it would be obvious to the ordinary artisan that a probe from within the sequence of BE013065 would be useful in detecting the larger sequence. The rejection is therefore maintained.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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A handwritten signature in black ink that reads "Jehanne Sitton". The signature is written in a cursive style with a long horizontal stroke at the end.

Jehanne Sitton
Primary Examiner

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6/15/07